

COPY OF PAPERS
ORIGINALLY FILED

#7 #6
52382
RECEIVED

MAY 15 2002

TECH CENTER 1600/2900

APPLICANT(S) : Deborah C. Mash
SERIAL NO. : 09/486,613
FILED : February 29, 2000
FOR : Noribogaine in the Treatment of Pain and Drug Addiction

GROUP ART UNIT : 1617
Examiner : Karl J. Stiller

Commissioner for Patents
Washington, D.C. 20231

Election of Invention in Response to Restriction Requirement

SIR:

In response to the Examiner's correspondence dated November 26, 2002, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicant provisionally elects with traverse to prosecute the invention set forth in Group II, claims 6-9 which is drawn to a method for alleviating pain in a patient comprising the concomitant administration of noribogaine and one or more opioid antagonists. However, Applicant respectfully request the Examiner to give careful consideration in allowing Applicant to elect the inventions of Groups I and II, claims 1-9 which are directed to a method of alleviating pain in a patient comprising administering noribogaine (claims 1-5) or a combination of noribogaine and one or more opioid antagonists (claims 6-9). Applicant respectfully submits that the examination of claims 1-9 will by necessity result in the same search required for examination of invention group II and consequently, claims 1-9 should be examined in this application in order to promote administrative efficiency. The reasons for Applicant's view is set forth in detail below.

Applicant respectfully traverses the Examiner's requirement for restriction. Applicant respectfully submits that prosecution of the originally filed claims should not be restricted to the elected invention and all the claims of the instant application should be examined in this application. However, short of that possibility, Applicant respectfully requests the Examiner examiner the inventions of groups I and II in this application, without further restriction. .

Pursuant to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions

NO8-002r.str
April 25, 2002

is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of claims 1-9 would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims 1-9 are related, though patentably distinct methods of alleviating pain in patients.

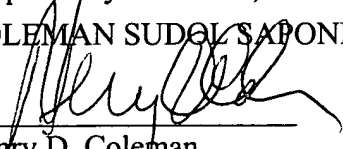
Although the claimed methods are generally patentably distinct from each other, Applicants respectfully submit that any search the Examiner would need to conduct in examining claims 1-9 of the instant application would not be unduly burdensome. ***Indeed, the Examiner's search would be the same.*** Inasmuch as Applicant has elected to prosecute claims 6-9 which are directed to a method of alleviating pain using the concomitant administering of *noribogaine and at least one other opioid antagonist*, it is respectfully submitted that the Examiner will, ***by necessity***, need to search the invention of Group I (noribogaine alone) in order to determine the patentability of the Group II invention (noribogaine plus an opioid antagonist), especially if the Examiner is to rely on a combination of references in making a rejection of claims 6-9.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations clearly weigh against restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes that the Patent Office examine his or her application with a degree of "judicial efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention. In the instant case, Applicants will have to refile the non-elected claims in a divisional application and prosecute that application at greater expense.

Applicants respectfully submit that all of the originally filed claims and certainly claims 1-9 of invention groups I and II are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement. Alternatively, Applicants respectfully request that the Examiner extend favorable consideration to examining all of the claims of groups I-II inasmuch as the methods overlap and any search to be conducted would be identical.

A four month extension of time (through April 26, 2002) is enclosed as is a check in the amount of \$720.00. The commissioner is authorized to charge any additional fee or to credit any overpayment to deposit account 04-0838.

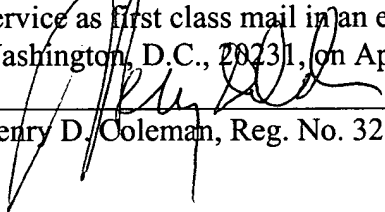
Respectfully submitted,
COLEMAN SUDOL SAPONE, P.C.

By: 
Henry D. Coleman
Reg. No. 32,559
714 Colorado Avenue
Bridgeport, Connecticut 06605-1601
(203) 366-3560

Dated: April 25, 2002

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C., 20231, on April 25, 2002.


Henry D. Coleman, Reg. No. 32,559